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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/008,951 | 12/05/2001 | Kurt M. de Grosz | 020884-000310US | 3716 |
| 20350 | 7590 | 02/01/2006 | EXAMINER | |
| TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834 | | | COBANOGLU, DILEK B | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3626 | |

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------|-----------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/008,951 | DE GROSZ ET AL. |
| | Examiner | Art Unit |
| | Dilek B. Cobanoglu | 3626 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 05 December 2001.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-23 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/05/2001.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

1. Claims 1-23 have been examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-8, 10, 12, 14-21, and 23 are rejected under 35 U.S.C. 102(e) as being unpatentable by Esposito (US Patent Publication No. 2001/0051906 A1).

A. As per claim 1, Esposito discloses a computer-implemented method for renewing a benefit product, said method comprising:

- i. providing a carrier with a renewal request for a current benefit plan, wherein said current plan includes current plan information (Esposito; par. 0009);
- ii. responding to a broker by providing a renewed plan (Esposito; par. 0023 and 0024);
- iii. saving said renewed plan by said broker in a system database, thereby archiving said current plan and renewing said benefit product (Esposito; par. 0035 and 0071).

B. As per claim 2, Esposito discloses the computer-implemented method for renewing a benefit product of claim 1, wherein said current plan information has at least one member of the group consisting of a benefit summary, a specific plan information, an eligibility rule, a rate and a message (Esposito; par. 0073).

C. As per claim 3, Esposito discloses the computer-implemented method for renewing a benefit product of claim 1, wherein said renewed plan has at least one member of the group consisting of an updated plan information, an updated rate information, or no changes at all, to the current plan (Esposito; par. 0051).

D. As per claim 4, Esposito discloses the computer-implemented method for renewing a benefit product of claim 1, wherein said renewal request is generated by said broker (Esposito; par. 0024 and 0025).

E. As per claim 5, Esposito discloses the computer-implemented method for renewing a benefit product of claim 1, wherein said renewal request is generated by a system (Esposito; par. 0009).

F. As per claim 6, Esposito discloses the computer-implemented method for renewing a benefit product of claim 1, wherein said renewal request comprises an e-mail message to a carrier containing a URL leading to a renewal request summary for a client (Esposito; par. 0009 and 0045).

G. As per claim 7, Esposito discloses the computer-implemented method for renewing a benefit product of claim 4, wherein said renewal request

comprises plans selected by said broker, a due date, a carrier instruction and a file attachment (Esposito; par. 0009).

H. As per claim 8, Esposito discloses the computer-implemented method for renewing a benefit product of claim 5, wherein said renewal request comprises all current plans up for renewal (Esposito; par. 0009).

I. As per claim 10, Esposito discloses the computer-implemented method for renewing a benefit product of claim 6, wherein said renewal request summary comprises at least one member of the group consisting of a current benefit summary, plan information, rate information and a carrier instruction (Esposito; par. 0035).

J. As per claim 12, Esposito discloses the computer-implemented method for renewing a benefit product of claim 1, wherein said renewed plan provides a change in benefit summary and plan information of said benefit product (Esposito; par. 0037).

K. As per claim 14, Esposito discloses the computer-implemented method for renewing a benefit product of claim 1, wherein said benefit product is selected from the group consisting of medical insurance, dental insurance, vision insurance, life insurance, std insurance, LTD insurance, death benefits, term life insurance, workers compensation, a section 125 plan, a stop loss plan, whole life insurance, variable life insurance, annuities, mutual funds, IRA, travel accident and accidental death and dismemberment, employee assistance programs, individual homeowner's insurance, renter's insurance, auto insurance, umbrella liability insurance,

health insurance, non-qualified retirement plans, and 401(k) plan (Esposito; par. 0037).

L. As per claim 15, Esposito discloses the computer-implemented method for renewing a benefit product of claim 4, wherein said renewal request is tracked by said broker prior to sending to said carrier (Esposito; par. 0009).

M. As per claim 16, Esposito discloses a system for renewing a benefit product, said system comprising:

i. a renewal module for sending a carrier a renewal request having a current plan having plan information, wherein said carrier renews said current plan by updating said plan information to generate a renewed plan accessible by a broker (Esposito; par. 0037); and

ii. a system database coupled to said renewal module for closing said renewal request, making effective said renewed plan and archiving said current plan (Esposito; par. 0035 and 0071).

N. As per claim 17, Esposito discloses the system for renewing a benefit product of claim 16, wherein said archiving of said current plan is 30 days after said renewed plan is effective (Esposito; par. 0077).

O. As per claim 18, Esposito discloses the system for renewing a benefit product of claim 16, wherein said current plan comprises a benefit summary, plan information, eligibility rules, rates and messages (Esposito; par. 0073).

P. As per claim 19, Esposito discloses the system for renewing a benefit product of claim 16, wherein said renewal request is generated by a broker (Esposito; par. 0025 and 0026).

Q. As per claim 20, Esposito discloses the system for renewing a benefit product of claim 16, wherein said renewal request is generated by said system (Esposito; par. 0009).

R. As per claim 21, Esposito discloses the system for renewing a benefit product of claim 16, wherein said renewal request comprises an e-mail message to a carrier containing a URL leading to a renewal request summary for a client (Esposito; par. 0009).

S. As per claim 23, Esposito discloses the system for renewing a benefit product of claim 16, wherein said benefit product is selected from the group consisting of medical insurance, dental insurance, vision insurance, life insurance, std insurance, LTD insurance, death benefits, term life insurance, workers compensation, a section 125 plan, a stop loss plan, whole life insurance, variable life insurance, annuities, mutual funds, IRA, travel accident and accidental death and dismemberment, employee assistance programs, individual homeowner's insurance, renter's insurance, auto insurance, umbrella liability insurance, health insurance, non-qualified retirement plans, and 401(k) plan (Esposito; par. 0037).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Esposito (US Patent Publication No. 2001/0051906 A1) in view of Segal (U.S. Patent No. 6,615,181 B1).

A. As per claim 9, Esposito discloses the computer-implemented method for renewing a benefit product of claim 6,

Esposito fails to expressly teach the renewal request summary comprises a census and attachment for said client per se, since it appears that Esposito is more directed to a method and apparatus for automatically distributing, recording, monitoring, and re-creating communications to participants of an employee benefit plan.

However, this feature is well known in the art, as evidenced by Segal.

In particular, Segal discloses a renewal request summary comprises a census and attachment for said client (Segal; col.3, lines 19-29).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the a method and

apparatus for automatically distributing, recording, monitoring, and re-creating communications to participants of an employee benefit plan with the renewal request summary comprises a census and attachment for said client with the motivation of based upon the census data generate insurance documentation including premium structure. (Segal; col. 8, lines 56-62).

6. Claims 11, 13, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esposito (US Patent Publication No. 2001/0051906 A1) in view of Mangin et al. (US. Patent No. 6,078,890).

A. As per claim 11, Esposito discloses the computer-implemented method for renewing a benefit product of claim 1,

Esposito fails to expressly teach the renewed plan provides a change in rate of said benefit product per se, since it appears that Esposito is more directed to a method and apparatus for automatically distributing, recording, monitoring, and re-creating communications to participants of an employee benefit plan. However, this feature is well known in the art, as evidenced by Mangin et al.

In particular, Mangin et al discloses a renewed plan provides a change in rate of said benefit product. (Mangin et al.; col.1, line 66 to col.2, line 11).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the a

method and apparatus for automatically distributing, recording, monitoring, and re-creating communications to participants of an employee benefit plan with the renewed plan provides a change in rate of said benefit product with the motivation of all data and calculations are automatically performed again using the most current information stored in database. (Mangin et al.; col. 3, lines 44-47).

B. As per claim 13, Esposito discloses the computer-implemented method for renewing a benefit product of claim 1,

Esposito fails to expressly teach carrier and said broker negotiate said renewed plan per se, since it appears that Esposito is more directed to a method and apparatus for automatically distributing, recording, monitoring, and re-creating communications to participants of an employee benefit plan. However, this feature is well known in the art, as evidenced by Mangin et al.

In particular, Mangin et al discloses carrier and said broker negotiate said renewed plan (Mangin et al.; col.1, line 66 to col.2, line 11).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the a method and apparatus for automatically distributing, recording, monitoring, and re-creating communications to

participants of an employee benefit plan with carrier and broker negotiate renewed plan with the motivation of subsequent rate renewal and qualitative analysis. (Mangin et al.; col. 2, lines 11-17).

C. As per claim 22, Esposito discloses the system for renewing a benefit product of claim 16.

The obviousness of modifying the teaching of Esposito to include the carrier and broker negotiate renewed plan (as taught by Mangin et al) is as addressed above in the rejection of claim 13 and incorporated herein.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not used prior art teach "Automated contract negotiator/generation system and method" 6,067,531 A, "Automated insurance system and method" 2002/0002475, "Managing health care resources" 2002/0035529, "Insurance marketing method and system" 2002/0046063, "System and method for facilitating selection of benefits" 2002/0049617, "Vehicle lease exchange method & system" 2002/0099618, "Method and Apparatus for Internet on-line insurance policy service" 2002/0116228, "System and method for building and manipulating a centralized measurement value database" 2002/0186818, "Method of customizing a browsing experience on a world-wide-web site" 6,734,886 B1, "Alert notification system" 6,816,878 B1.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DBC

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